

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	
Edward Rodriquez et al.	)	Group Art Unit: 3621
Application No.: 09/811,823	)	Examiner: NANCY LOAN T LE
Filed: March 20, 2001	)	Appeal No.: _____
For: METHOD AND SYSTEM FOR	)	
ELECTRONIC VOTER REGISTRATION	)	
AND ELECTRONIC VOTING OVER A	)	
NETWORK	)	

**REPLY BRIEF**

**Mail Stop APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Examiner's Answer dated September 17, 2008 raises the following new issues:

- I. Whether, Under 35 U.S.C. §103, Appellants' Independent claim 1 With Its Recitation Of A New Function, "is merely a combination of old elements" Wherein Each Element Performs The Same Function As It Did Separately In The Prior Art.
- II. Whether, Under 35 U.S.C. §102, A Request To Vote Constitutes An Implicit And Inherent Request For A Voter Registration Status And/Or A Ballot Status As Is Recited In Claim 20.

- I. Appellants' Independent Claim 1 Is Directed To A Novel, Non-obvious Function Of Establishing Registration Of A Voter, And Is Not Merely A Combination Of Old Elements Which Perform The Same Functions They Did Separately In The Prior Art.

Applicants' independent claim 1 recites use of a first computer and a transaction repository server to **establish a registered voter** over a computer network (e.g., the Internet), such that the registered voter can transmit a voted electronic ballot from a second computer. On page 6 of the Examiner's Answer, the Examiner now asserts that the claim 1 invention:

"... is merely a combination of old elements, and in the combination, each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable." [Examiner's Answer at p. 6, 1st para.]

The Examiner's newly added "Response To Argument" asserts this same point. [Examiner's Answer at p. 26, ll. 14-17.]

The Examiner's assertions are inaccurate, and the rejection under 35 U.S.C. §103 is therefore inconsistent with the decision in KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) because the McClure and Bayer patents, even when combined in the manner suggested by the Examiner, lack an element of claim 1; namely, the claim element regarding "transmitting registration information from the first computer, via the transaction mediator, to a computer database that resides on a transaction repository server, all of which are networked together, to establish a registered voter. Claim 1 also recites "transmitting a blank electronic ballot, upon request by the registered voter at a second computer". Claim 1 is directed to a method and mechanism whereby a voter can be established as a "registered voter" over a computer network, so that the "registered voter" can receive a blank electronic ballot at a second computer.

Contrary to the assertion in the last full paragraph on page 26 of the Examiner's Answer, "establishing voter registration is a prerequisite to vote" is clearly recited in claim 1. Claim 1 specifically recites that a voter who has been established

over the network as a registered voter can receive an electronic ballot over the network.

Appellants' claimed invention provides numerous advantages. For example, a secure mechanism is disclosed and claimed whereby voters can be established as registered voters over a computer network. Properly registered voters are then entitled to receive an electronic ballot and vote from a second computer, different from the computer used to establish a registered voter.

The McClure and Bayer patents do not disclose or suggest a system or method whereby establishment of a registered voter is performed electronically, over a network, for subsequent electronic voting via a second computer. McClure is acknowledged by the Examiner as lacking electronic voter registration as presently claimed. Bayer is cited as disclosing "registration", but the "registration" disclosed by Bayer is simply a polling or survey process to acquire data for input to a database. Neither McClure nor Bayer disclose or suggest establishment of an electronically registered voter over a computer network; i.e., establishing over a computer network that a citizen is entitled to vote so that an electronic ballot can be transmitted to the registered voter.

As such, independent claim 1 is allowable. Independent Claims 23 and 32 are also allowable, as are the claims which depend therefrom.

- II. Applicants' Claim 20 Request Of A Status Message And Transmitting Of A Status Message Regarding Voter Registration Status And/Or Voter Ballot Status Is Different From A Request To Vote, Such That Claim 20 Is Novel Under 35 U.S.C. §102.

The Examiner asserts on page 28 of the Examiner's Answer that:

*Furthermore, as the voter requests to vote [in the McClure Patent], the voter has been verified [by the TNC 50] that he/she has not already voted [i.e., the citizen implicitly and inherently requests for a status of an electronic ballot ... **McClure**, see at least (col. 42, lines 36-59).*

[Examiner's Answer at p. 28, [underlining added; italics and bold in original].

Applicants' claim 20 recites specifically that a "status message" is determined in response to the step of receiving "a citizen's request regarding status of at least

one of the citizen's voter registration and the citizen's electronic ballot status." Claim 20 recites "transmitting the status message."

Contrary to the Examiner's assertions, the cited portions of the McClure patent are directed to voter validation using manual intervention by an election official, and do not address determining and transmitting, in response to a citizen's request over a network, a status message separate and distinct from an electronic ballot.

As such claim 20 is novel under 35 U.S.C. §102 and the rejection of claim 20, (and independent claim 46), should be reversed.

### CONCLUSION

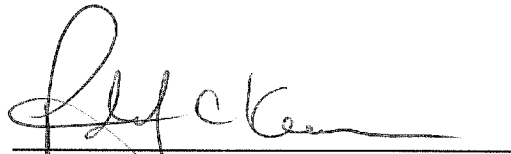
Appellants' claims are allowable, and it is respectfully requested that the final rejection be reversed.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date November 17, 2008

By:



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